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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,355	02/06/2006	Kuon Miyazaki	P29200	5221
7055 7590 01/09/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER BERMAN, SUSAN W				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 01/09/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary

Application No.

10/567,355

Applicant(s)

MIYAZAKI ET AL.

Examiner

/Susan W. Berman/

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 10-17-2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Drawings

The requirement for corrected drawings is withdrawn in response to applicant's argument that Figure 1 includes an adhesive layer 7 comprising the instantly claimed composition.

Response to Amendment

The rejection of claims 4 and 5 under 35 U.S.C. 112, second paragraph, is withdrawn in response to the amended claims.

The rejection of product claims 6, 10-12 and 15-17 under 35 U.S.C. 102(b) as being anticipated by Ogima et al (6,361,866).

The rejection of claims 1-4, 6-8, 10 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over by Ogima et al (6,361,866) in view of EP 0 831 127 is withdrawn.

Neither Ogima et al nor EP 0 831 127 teaches compositions comprising a hydroxy-functional compound also containing a vinyl ether group or an oxetanyl group, as now set forth in claim 1.

Response to Arguments

Applicant's arguments, see Remarks, filed 10-17-2008, with respect to the rejections set forth in the office action mailed 4-18-2008 have been fully considered and are persuasive. The rejections over prior art has been withdrawn, as set forth above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 19 and 20, it is not clear what is meant by the phrase “wherein either of the ortho positions of each hydroxyl group is not substituted with any of a methylol group...carbon atoms”. It is not clear how a hydroxyl group has an ortho position that can be substituted. Does applicant mean to recite that neither of the positions ortho to the hydroxyl group is substituted? If so, it should be so stated. Does applicant intend to recite that at least one of the positions ortho to the hydroxyl group is not substituted with a methylol group? If so, it should be so stated. If another meaning is intended it should be clarified. See paragraphs [0038-0039] in PGPUB 2006/0222999 A1.

In claims 1, 4, 5 and 19, the use of the word “plurality” renders the claims indefinite because it is not clear whether applicant is claiming an amount of the compounds of the formula set forth or a mixture of different species within the formula set forth. What applicant discloses is that the different polynuclear phenol compounds disclosed can be used singly or in combinations of two or more (paragraph [0051]).

In claim 4, what is meant by “all of the plurality of R in the formula each may be the same or different? Does applicant intend to set forth that each R in the formula may be the same or different? If so, it should be so stated.

In claims 6 and 17, it is suggested that “active beam” should read “active energy beam”.

In claim 11, the manner of “using” the photosensitive adhesive as a “sealer” should be clearly set forth.

Allowable Subject Matter

Claim 1, 19 and 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 3-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The following references are cited as art of interest.

Hayashi (US 2006/0202220 A1) discloses a display device obtained by sealing two substrates with a cationically polymerizable composition, such as an epoxy, oxetane, hydroxyl, vinyl ether, episulfide or ethyleneimine containing composition.

Ogura et al (7,087,702) disclose phenol resins and epoxy resins containing aliphatic cyclic hydrocarbon groups such as dicyclopentadienyl moieties.

Hayashi et al (6,599,954) disclose radiation curable epoxy resins and initiators for carbon fiber-reinforced materials.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Susan W. Berman/ whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Scidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB
12/28/2008

/Susan W Berman/
Primary Examiner
Art Unit 1796